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NOTES/COMMENTS:

Please see attached herewith:

☒ Appeal Brief - in triplicate (13 pages)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
RABINDRANATH DUTTA

Serial No.: **09/534,592**

Filed: **03/27/2000**

For: **METHOD TO ELIMINATE BOOK
MARKING FALSE SERVERS**

ATTORNEY DOCKET NO.:
AUS000003US1

Examiner: **THU HA T. NGUYEN**

Art Unit: **2155**

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APPEAL BRIEF UNDER 37 C.F.R. 1.192

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Appeal Brief is submitted in triplicate in support of an Appeal of the Examiner's final rejection of December 1, 2003, in the above-identified application. A Notice of Appeal was filed in this case on February 24, 2004 and received in the patent office on February 24, 2004. Please charge the fee of \$320.00 due under 37 C.F.R. § 1.17(c) for filing the brief, as well as any additional required fees, to IBM Deposit Account No. 09-0447.

CERTIFICATE OF FACSIMILE TRANSMISSION	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, M/S Appeal Brief, Patents, at 703-872-9306 on the date set forth below.	
Date: <u>7/6/04</u>	Signature: <u>Stephen A. Mason</u>

REAL PARTY IN INTEREST

The real party in interest in the present Appeal is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment recorded at reel 010627 and frame 0335 *et. seq.*

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-7 were originally presented. In Appellants' Amendment A, filed on December 1, 2003, Claims 1-2, 4 and 7 were amended, and new Claims 8-21 were added. The amendment to Claim 7 represented merely a change of capitalization. Claims 1-21 stand finally rejected by the Examiner as noted in the Final Office Action dated February 3, 2004.

STATUS OF AMENDMENTS

Appellants' Amendment A, filed on December 1, 2003, was entered by the Examiner. No amendments to the claims have been made subsequent to the final rejection that leads to this appeal.

SUMMARY OF THE INVENTION

The present invention provides a new personal computer feature, which regulates access to data stored in a personal computer system from the time at which transportation outside of an authorized zone occurs to the time at which a clear signal is received. In particular, the invention addresses the problem of removal without authorization by disabling the computer after exposure to radiation of a predefined characteristic as it enters a "control zone." By so disabling a computer and then selectively enabling the computer in response to receipt of a radiation signal, it is possible to deter theft.

In one embodiment, described at page 6, line 1 *et seq.*, the computer system 10 (Figure 1), using a known radio frequency identification system 160 (page 13, line 7 *et seq.* and Figure 3), signals its identification in response to radiation (e.g., radiation at a particular predefined frequency) in a control zone 500 (Figure 10). Radiation (page 26, line 15 *et seq.* and Figures 2 & 10), preferably the same radiation, triggers a detector 160 that causes the computer to set its tamper-evident bit in a register 114 contained within EEPROM 70 (see Figure 4), disabling the computer (page 13, line 15 *et seq.*). In a presently preferred implementation, setting the tamper-evident bit causes the computer to be unusable until receipt of a clear signal following detection of a second radiation signal (page 26, line 15 *et seq.*).

ISSUES

- (1) Is the Examiner's rejection of Claims 1-3, 6, and 8-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,227 to Dayan *et al.* (*Dayan I*) in view of U.S. Patent No. 5,712,973 to Dayan *et al.* (*Dayan II*) well founded?
- (2) Is the Examiner's rejection of Claims 1-3, 6, 8, 13 and 15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 U.S. Patent No. 5,970,227 to Dayan *et al.* (*Dayan I*) in view of U.S. Patent No. 5,712,973 to Dayan *et al.* (*Dayan II*) well founded?

GROUPING OF THE CLAIMS

For purposes of this Appeal, all claims stand or fall together as a single group.

ARGUMENT

In the Examiner's Final Office Action dated February 3, 2004 and labeled paper #9, the Examiner rejected Claims 1-3, 6, and 8-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,227 to Dayan *et al.* (*Dayan I*) in view of U.S. Patent No. 5,712,973 to Dayan *et al.* (*Dayan II*). That rejection is not well founded and should be reversed.

- I. The cited combination of Dayan I and Dayan II does not teach or suggest each element recited in exemplary Claim 1.

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- A. The recited "detector, within the housing, for detecting radiation of a second predetermined characteristic which upon a detection produces a clear signal" is not taught or suggested by *Dayan I* and *Dayan II*.

In rejecting Claim 1, the Examiner has relied upon a combination of elements alleged to be present in *Dayan I* with elements alleged to be present in *Dayan II*. Appellants respectfully submit that Claim 1 is not rendered unpatentable by the combination of *Dayan I* and *Dayan II*, because the Examiner has failed to articulate a *prima facie* case of obviousness. As is well settled in the law, a *prima facie* case of obviousness for rejecting claims under 35 U.S.C. § 103 requires, *inter alia*, a showing that the prior art teaches or suggests all of the recited limitations of Appellants' claim. *M.P.E.P.* § 2142. In his final Office Action, the Examiner fails to meet his burden of making such a *prima facie* case because the cited text of *Dayan II* does not provide the functionality recited in Appellants' claims.

The Examiner correctly asserts at paragraph 6 of the Final Rejection dated February 3 and labeled as paper #9 that "*Dayan I* fails to teach a detector for radiation within the housing that produces a clear signal responsive to detection of a second characteristic to indicate detection has occurred and power on logic that is enabled in response to a clear signal." The Examiner then alleges that *Dayan II* shows "a detector for radiation within the housing that produces a clear signal responsive to detection of radiation of a second charactersite to indicate that detection has occurred" at Column 10, lines 2-9. However, upon review of the cited passage, Appellants respectfully traverse the Examiner's rejection, because the cited text does not teach or show the Appellants' recited feature of, "a detector, within the housing, for detecting radiation of a second predetermined characteristic which upon a detection produces a clear signal." Specifically, the cited text (*Dayan II*, Column 10, lines 2-9, quoted through line 16 below), shows a detector for detecting the absence of radiation:

According to the invention the detector 114 supplies its output signal indicating the presence of radiation of the predefined type to a transistor 110 which is in the conducting state when radiation is present causing a transistor 108 to be in the off state to place a logic zero in the *loss of RF detected flag* in a register 118 of the RTC and C-MOS memory 68. When the radiation level falls to a level at which detector 114 turns off transistor 110, which in turn causes transistor 118 to be

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conducting and if the enabling signal EN₁₃CONT is a one at input 107 of a transistor 106, a 1 is placed in the loss of RF detected flag at register 118. As is discussed below with respect to FIG. 8a this flag causes the POST logic to require the PAP before completing the setup sequence to make the computer 10 operable.” (*emphasis added*).

Clearly, rather than showing Appellants’ claimed feature of “a detector, within the housing, for radiation of a second predetermined characteristic which upon a detection produces a clear signal”, the cited text of *Dayan II* shows a detector for detecting the *absence or loss* of radiation. In addition to not showing the functionality recited in Appellants’ invention, detector 114 of *Dayan II* actually teaches away from Appellants’ invention because detector 114 detects the absence rather than the presence of radiation.

B. The recited “enabling operation of said electronic apparatus in response to said clear signal” is not taught or suggested by *Dayan I* and *Dayan II*.

At page 3 of the Final Rejection, the Examiner further alleges that *Dayan II* teaches, “enabling operation of the electronic apparatus in response to a clear signal” at Column 10, lines 2-16. However, upon review of the cited passage, Appellants respectfully traverse the Examiner’s rejection, because the cited text does not teach or show the Appellants’ recited feature of, “enabling operation of said electronic apparatus in response to said clear signal.” Specifically, the cited text (*Dayan II*, Column 10, lines 2-16), shows enabling operation of an electronic device in response to a privileged access password (PAP):

According to the invention the detector 114 supplies its output signal indicating the presence of radiation of the predefined type to a transistor 110 which is in the conducting state when radiation is present causing a transistor 108 to be in the off state to place a logic zero in the loss of RF detected flag in a register 118 of the RTC and C-MOS memory 68. When the radiation level falls to a level at which detector 114 turns off transistor 110, which in turn causes transistor 118 to be conducting and if the enabling signal EN₁₃CONT is a one at input 107 of a transistor 106, a 1 is placed in the loss of RF detected flag at register 118. As is discussed below with respect to FIG. 8a this flag causes the POST logic to require the PAP before completing the setup sequence to make the computer 10 operable.” (*emphasis added*).

Clearly, rather than showing Appellants' claimed feature of "enabling operation of said electronic apparatus in response to a clear signal" generated responsive to detection radiation, the cited text of *Dayan II* shows requiring a password in order to enable operation of the electronic device.

In summary, Appellants' claim recites detection of a second radiation, generation of a clear signal, and subsequent enablement of a computer system, while the Examiner's cited combination of *Dayan I* and *Dayan II* discloses detection of the absence of radiation and the receipt of a password prior to enabling a computer system. Clearly, the cited combination of *Dayan I* and *Dayan II* does not disclose each of the features recited in Appellants' exemplary Claim 1. Moreover, the cited combination of *Dayan I* and *Dayan II* provides no teaching or suggestion to modify the references and thereby obtain Appellants' claimed invention. Consequently, the Examiner's combination of *Dayan I* and *Dayan II* cannot render the present invention obvious, and the Examiner's rejections should be reversed.

II. The Claim Rejection for double patenting is not supported with a rationale.

In paragraph 15 of the Examiner's Final Office Action dated February 3, 2004 and labeled paper #9, the Examiner rejected Claims 1-3, 6, 8, 13 and 15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 5,970,227 to *Dayan et al. (Dayan I)* in view of U.S. Patent No. 5,712,973 to *Dayan et al. (Dayan II)*. That rejection is not well founded and should be reversed.

The Examiner has cited no rationale for the double patenting rejection with respect to exemplary Claim 1, merely instructing Appellants to "see the above rejection for these claims and for the rationale for the combination of the two references." Appellants traverse the double patenting rejection of Claims 1, 8, and 15 for the reasons cited with respect to the rejection of exemplary Claim 1 under 35 U.S.C. §103.

Specifically, as discussed above with respect to the Examiner's rejection for obviousness, exemplary Claim 1 recites detection of a second radiation, generation of a clear signal, and subsequent enablement of a computer system, while the Examiner's cited combination of *Dayan I* and *Dayan II* requires a detection of the absence of radiation and the receipt of a password prior

to enabling a computer system. Again the cited combination of *Dayan I* and *Dayan II* provides no suggestion or motivation to modify the inventions claimed therein to obtain the present invention, as recited in exemplary claim 1. Accordingly, the double patenting rejection is not well founded and should be reversed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the combination of references. Appellants, therefore, respectfully request that the rejection of each pending claim be reversed.

Respectfully submitted,



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APPENDIX

1. A computer system which stores and processes data having a security system to control access to that data in the event of an unauthorized movement of such system through a control zone where radiation having a distinctive characteristic is present, said system comprising:

a housing adapted to be capable of being transported by a human user;

an electronic computing apparatus, within the housing, which when energized, becomes operative by a power on logic sequencing through set up operations;

a detector for radiation, within the housing, for detecting radiation, which upon a detection of radiation having a first characteristic produces an alarm signal to indicate a detection has occurred and produces a clear signal responsive to detection of radiation of a second characteristic to indicate a detection has occurred; and

security logic, within the housing, connected to receive said alarm signal and cooperating with said power-on logic to prevent said electronic apparatus from becoming operative in response to said alarm signal and enabling operation of said electronic apparatus in response to said clear signal.

2. A computer system according to Claim 1 wherein said radiation is a radio frequency signal and the first characteristic is the frequency of the radiation.

3. A computer system according to Claim 1 which further includes password checking logic, a display device and a user operable input device and wherein said password checking logic prompts the user for a password if an alarm signal is present and disables said security logic from preventing said electronic computing apparatus from becoming operative if the correct password is asserted at said input device.

4. A security system comprising:

a first radiation transmitter at a control zone exposing said control zone to radiation having a first distinctive characteristic;

at least one computer system having:

start-up logic that upon energization sequences the computer system through a process to become operational;

and an identifier device that detects radiation having said first distinctive characteristic, responsively emits radiation bearing a respective encoded serial number signal and sets a disable bit that activates logic that blocks said process for making the computer operative;

a tamper detection switch for detecting opening of the case of said computer system and, responsive to opening of said case of said computer system, disabling said computer system;

a radio frequency-enabled electronically erasable programmable read only memory circuit tuned on a particular radiation characteristic, including an electronically erasable programmable read only memory, a serial interface for inputting and outputting signals, a radio interface for receiving wireless signals, and detector logic, wherein said electronically erasable programmable read only memory circuit stores a privileged access password and is controlled by a security switch for setting a write state and an inactive state of said electronically erasable programmable read only memory;

a storage unit with instructions for, responsive to a setting of said disable bit requiring an administrator-level password for making said unit operative; and

a non-volatile, battery-powered, complementary metal-oxide semiconductor for storing a privileged access password;

an input receiver for a user ID;

a receiver near said control zone responsive to said serial number signal which performs a search on a list of serial numbers to determine if the received serial number is listed and matches

the user ID and produces a clear alarm signal if a match is found;

a transmitter, responsive to the clear signal, that emits radiation having a second distinctive characteristic into the control zone; and

said computer system including security logic cooperating with said start-up logic and responsive to said clear signal to enable said start-up logic to make said computer system operative.

5. A security system according to Claim 4 wherein said first and second distinctive characteristics are first and second frequencies and the radiation is radio frequency radiation.

6. A security system according to Claim 1 wherein said computer system further includes password checking logic, a display device and a user operable input device and wherein said password checking logic prompts the user for a high level password if the disable bit is set and disables said security logic from preventing said electronic computing apparatus from becoming operative if the correct password is asserted at said input device.

7. A security system according to Claim 1 wherein detectors detect the direction of movement of the computer system and security logic sends a clear signal if the system is entering.

8. A method of securing data on a computer system, said method comprising:
 - detecting radiation being broadcast in a control zone;
 - upon detecting radiation having a first distinctive characteristic, producing an alarm signal to indicate a detection has occurred;
 - upon detecting radiation having a second distinctive characteristic, producing a clear signal;
 - upon energizing a computing apparatus, sequencing through set up operations;
 - responsive to receiving said alarm signal within the computer system, preventing said computer system from becoming fully operative; and
 - responsive to receiving said clear signal within said computer system, enabling operation of said computer system.
9. The method of Claim 8, further comprising, responsive to receiving said alarm signal followed by said clear signal, canceling said alarm signal and enabling operation of said computer system.
10. The method of Claim 8, further comprising, responsive to receiving a privileged access password after receiving said alarm signal, enabling operation of said computer system.
11. The method of Claim 8, further comprising, responsive to receiving an off-site user password after receiving said alarm signal, enabling operation of said computer system.
12. The method of Claim 8, wherein said detecting step further comprises detecting radiation with a computer system.
13. The method of Claim 8, wherein detecting radiation having a first distinctive characteristic further comprises, detecting radiation having a pre-defined frequency.

14. The method of Claim 8, further comprising, responsive to receiving a power-on password, enabling operation of said computer system.

15. A computer program product on a computer readable medium for securing data on a computer system, said computer program product comprising:

instructions on the computer readable medium for detecting radiation being broadcast in a control zone;

instructions on the computer readable medium for, upon detecting radiation having a first distinctive characteristic, producing an alarm signal to indicate a detection has occurred;

instructions on the computer readable medium for, upon detecting radiation having a second distinctive characteristic, producing a clear signal;

instructions on the computer readable medium for, upon energizing a computing apparatus, sequencing through set up operations;

instructions on the computer readable medium for, responsive to receiving said alarm signal within the computer system, preventing said computer system from becoming fully operative; and

instructions on the computer readable medium for, responsive to receiving said clear signal within said computer system, enabling operation of said computer system.

16. The computer program product of Claim 15, further comprising, instructions on the computer readable medium for, responsive to receiving said alarm signal followed by said clear signal, canceling said alarm signal and enabling operation of said computer system.

17. The computer program product of Claim 15, further comprising, instructions on the computer readable medium for, responsive to receiving a privileged access password after receiving said alarm signal, enabling operation of said computer system.

18. The computer program product of Claim 15, further comprising, instructions on the computer readable medium for, responsive to receiving an off-site user password after receiving said alarm signal, enabling operation of said computer system.

19. The computer program product of Claim 15, wherein said detecting instructions on the computer readable medium for detecting radiation further comprise instructions on the computer readable medium for detecting radiation with a computer system.

20. The computer program product of Claim 15, wherein instructions on the computer readable medium for detecting radiation having a first distinctive characteristic further comprise instructions on the computer readable medium for detecting radiation having a pre-defined frequency.

21. The computer program product of Claim 15, further comprising, instructions on the computer readable medium for, responsive to receiving a power-on password, enabling operation of said computer system.